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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,631	04/02/2004	Paul Lapstun	HYG004US	9661
24011	7590	09/14/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			FRECH, KARL D	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/815,631

Applicant(s)

LAPSTUN ET AL.

Examiner

Karl D. Frech

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-19, 22, 23, 28, 29 and 31-38 is/are rejected.
- 7) ☒ Claim(s) 6, 20, 21, 24-27, 30 and 39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/2/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
2. Claim 39 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must refer in the alternative only. See MPEP § 608.01(n). Accordingly, the claim 39 has not been further treated on the merits.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5,14-17,22,23,28,34,36,37,38 are rejected under 35 U.S.C. 102(b) as being anticipated by Hecht et al 6,182,901. Hecht discloses as seen in figure 10 a square code which is rotatable about its center in at least quarter turns (i.e.  $n=4$ ). The pattern of glyphs on the boarder of the code are used to determine the codes orientation, i.e. sub-layouts indicating rotation. There are 4 different sub-layouts along the periphery of the code, i.e. at least one codeword in one sub-layout different from another codeword in another sub-layout. The sub-layouts along the periphery are used for orientation and thus are "targets", each of the four targets having at least 4 features (glyphs), each being made of at least 1 codeword. The specific information held within the code is interpreted merely as alternate data which does not further define the code pattern as claimed. It is inherent that individual codes distinguishes products.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 7-13,18,19,29,31,32,33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hecht et al 6,182,901.

Hecht discloses that which is seen above. Hecht does not disclose specifically that the code data identifies a product. However, Official Notice is taken that identifying products with optical codes is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the code of Hecht to identify a product therefore allowing for tracking of the product. Hecht further discloses that his individual "square" (examiner's words) codes are placed along with more similar "square" codes, i.e. part of a super-layout of tessellating tiles. The data "squares" are separated by a constant spacing interval of glyphs. Official Notice is also taken that

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redundant codes are old and well known. It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide redundant codes as this would allow for a product to be identified if one code were to be inadvertently destroyed. Hecht does not disclose the invisible code or IR ink as claimed. However, Official Notice is taken that codes consisting of IR ink are old and well known. It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to print the code of Hecht with IR ink. This would effectively "hide" the code from the naked eye, and therefore would not obscure the product being coded from the user. Hecht does not disclose that the code takes up at least one of 25%, 50%, 75% or 100% of the product surface. However, Official Notice is taken the applying a code over nearly and entire surface, or at least over more than 25% of a surface is old and well known. It would have been obvious to a person of ordinary skill in the art at the time of the invention to place a code over more than 25% of a surface of a product in order to maximize the amount of information within the code.

8. Claims 6,20,21,24-27,30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or fairly suggest to one of ordinary skill in the art at the time of the invention, in conjunction with all the other claimed limitations, the interleaved data elements of claim 6, identifying the identity of a region as in claim 20,

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identifying a respective position on a surface as in claims 21,25, the code being UPC or EPC as in claims 24,26-27, or the Reed-Solomon encoding of 30.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Johnson et al 3,808,405, Chan 5,825,015, Hara et al 5,726,435, Kost et al 5,554,841 and Zheng et al 5,515,447 all disclose symmetric codes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D. Frech whose telephone number is (571) 272-2390. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karl D Frech  
Primary Examiner  
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